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10/775,207	02/11/2004	Michael J. Hubbard	OMNO-0003-1	9961
7590 01/09/2007 David G. Burleson Chief Intellectual Property Counsel OMNOVA Solutions, Inc. 175 Ghent Road Fairlawn, OH 44333			EXAMINER ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/775,207  
Filing Date: February 11, 2004  
Appellant(s): HUBBARD, MICHAEL J.

**MAILED**

**JAN 09 2007**

**GROUP 1700**

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Mark J. Gutttag  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed August 21, 2006 appealing from the Office action mailed March 13, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. More particularly;

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

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Grounds of Rejection A relating to whether or not the claims comply with 35 USC 112, second paragraph, has been withdrawn by the Examiner.

### **NON-APPEALABLE ISSUES**

Appellant's brief presents arguments relating to:

(page 7) Allegation that an affidavit acquired pursuant to 37 CFR (hereinafter "Rule") 1.104(d)(2)) was not provided by the Examiner.

(page 9) Allegation that Rule 1.104(d)(2) affidavit has not been provided in Response to Request in After Final Amendment.

(pages 12,14,15,16,17, and 23) Allegations of Prior Art rejection flaws under MPEP 706.02(j) and Rule 1.104 (c) (2).

(page 10) Allegations concerning Actions not taken by Examiner during prosecution involving Final Office Action flaws.

In each of these instances the above cited Action has been included in the Brief, and the accompanying issue discussed. However, each of these issues relate to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. Accordingly, they will not be discussed in this Answer.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

US 5,456,785

Venable

10-1995

US 4,996,812

Venable

03-1991

WO 98/56866

TACC INTERNATIONAL 12-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 USC 103(a) as being unpatentable over the prior art combination of either Venable '785 or '812, each taken in view of WO '866.

The primary references each disclose (note particularly Venable '785, Col 1, lines 9-14, lines 22-25, lines 40-53, Col 2, lines 26-39, Col 3, lines 3-13, Col 7, lines 47-65; Venable '812, the Abstract, Col 1, lines 7-23, line 47-Col 2, line 17, Col 3, lines 20-27) covering products, e.g. such as roofing membranes, and accompanying processes of fabrication which comprise structures formed from flexible thermoplastic sheets adhered to a suitable fabric layer that is then secured to the substrate, such as the roof of a building, by a variety of adhesives (Venable '785, Col 1, lines 23-25) that has been previously deposited on the roof. As such, each reference lacks a teaching of a suitable adhesive layer on the opposing outer surface of the fabric from the thermoplastic layer.

The secondary reference, however, which is also taken from the adhesive roofing membrane art, discloses (note particularly WO '866, the Abstract, Figs 2 and 3, page 1, lines 5-15, page 2, lines 22-25, page 3, lines 4-23, page 5, line 28-page 6, line 1, lines 12-15 and lines 23-28) an extremely closely related adhesive coated polymer membrane (e.g. Page 2, lines 22-25, page 3, lines 4-7) which (page 6, lines 25-27) "can be used directly at the construction site to bond two surfaces together or at a manufacturing site to form an adhesive covering layer". As such WO '866 clearly renders obvious whatever structural connotations that may exist in appellant's claims

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involving the time of application of the adhesive, which require the presence of an adhesive applied to the article prior to adhering the covering product on the building structure (note appellant's claim 1). Accordingly, one of ordinary skill, motivated by the desire to form a roofing covering product and accompanying process of installation (i.e. mounting) while avoiding the use of harmful solvents, together with the resultant article having ease in application and use, would find that he had more than ample motivation to incorporate the outer adhesive layer of the secondary reference onto the outer layer surface of the fabric layer opposite from the thermoplastic layer of each of the primary references and thereby form the claimed article and accompanying method of installation. Note that roofing membranes are clearly examples of covering products (appellant's claim 1 preamble), and with respect to those dependent claims such parameters as the particular building structure such as a roof deck, an exposed section of a membrane, use of release liners, PVC as the thermoplastic material, use of non woven fabrics, fire retardants and the like are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

#### **(10) Response to Argument**

With respect to appellant's arguments which involve the 35 USC 103 rejections of record the following comments are deemed appropriate. Appellant's arguments (Brief, pages 13, 14) which attack each of the primary references as failing to teach the claimed invention and which also attack the Examiner as failing to teach where each of the teachings can be found are each significantly flawed. Note again that the prior art rejections which have been relied upon are **combination** rejections, so the

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allegations found here and elsewhere throughout the Brief against both of the Venable references and also against WO '866 (Brief, paragraph bridging pages 16-17) as not teaching the entirety of a particularly claim when taken individually are simply in most instances not particularly pertinent. Note also that in the initial Office Action, as well as in this Answer, the Examiner initially cites what portion or portions of the reference he thinks are particularly pertinent, and while this list may be added onto or somewhat deleted during subsequent prosecution he respectfully submits that almost all, if not all of the structural limitations which he cites can be found in these sections. Additionally, the Examiner also believes that he is well within his rights when he states that a particular structure, method or other issue(s) are well known to one of ordinary skill, even without expressly taking Official Notice thereof, unless specifically contested by appellant. Finally, the Examiner notes that a comment taken against WO '866 (Brief, page 19, lines 1-3) that the reference "does not teach or suggest the claimed feature of using an adhesive that is pre-applied to a fabric layer of a covering product prior to adhering the covering product to a building structure" should again note page 6, lines 23-28, particularly lines 25-27 with the proviso that the reference is not relied upon for a teaching of the fabric layer.

**(11) Related Proceeding(s) Appendix**

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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*Daniel Zuber*

Conferees:

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